

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 16

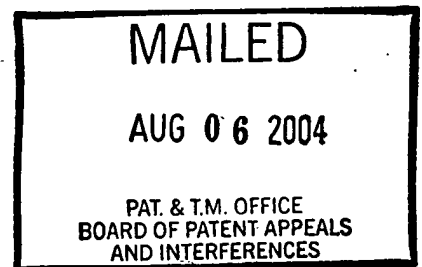
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RABINDRANATH DUTTA
and
KAMAL CHANDRAKANT PATEL

Appeal No. 2003-2068
Application No. 09/535,581

ON BRIEF



Before THOMAS, HAIRSTON, and BLANKENSHIP, Administrative Patent Judges.

THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

Appellants have appealed to the Board from the examiner's final rejection of claims 1 through 12 and 18 through 28.

Representative claim 1 is reproduced below:

1. A method for detecting copyright violation, said method comprising:

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receiving a selectable data stream of suspected copyright infringing material;

generating a first electronic signature for said data stream of said suspected copyright infringing material, said first electronic signature being a distillation, of said data stream, that is incapable of reconstructing said data stream by direct decipherment;

generating a second electronic signature for an original copyright material, said second electronic signature being a distillation, of said original copyright material, that is incapable of reconstructing said original copyright material by direct decipherment; and

comparing said first electronic signature with said second electronic signature, wherein a match of said first electronic signature with said second electronic signature indicates a likelihood that said suspected copyright infringing material and said original copyright material are the same.

The following references are relied on by the examiner:

Atkinson et al. (Atkinson)	5,892,904	Apr. 6, 1999
Ammar	6,424,728	Jul. 23, 2002 (filed Dec. 2, 1999)
Tsuria et al. (Tsuria)	6,466,670	Oct. 15, 2002 (filed Jan. 11, 2000)

Claims 1 through 12 and 18 through 28, all claims on appeal, stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner relies upon Atkinson in view of Tsuria as to claims 1 through 12 and 18 through 26, with the addition of Ammar as to claims 27 and 28.

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Rather than repeat the positions of the appellants and the examiner, reference is made to the brief and reply brief as to appellants' positions, and to the answer for the examiner's positions.

OPINION

We reverse the stated rejections of all claims on appeal under 35 U.S.C. § 103 and institute new grounds of rejection within 37 CFR § 1.196(b).

As to the first stated rejection, of claims 1 through 12, and 18 through 26, which the examiner considers obvious within 35 U.S.C. § 103 in view of Atkinson and Tsuria, we reverse this rejection. We reverse the rejection of each of independent claims 1, 7, 18 and 26 within this rejection since the examiner has not established pro forma a prima facie case of obviousness of the subject matter of these claims. The principal dispute between appellants and the examiner revolves around the dual recitation in independent claims 1, 7 and 18 as well as the single recitation in independent claim 26 relating to the electronic signatures being a distillation that is incapable of reconstructing the data stream by direct decipherment.

The examiner's position at page 4 of the answer sets forth alleged features of Atkinson that correlate to certain features of the independent claims on appeal and recognizes at page 5 of the answer that Atkinson fails to teach the substance of the earlier-noted questioned features. Even though the examiner recognizes that Atkinson fails to teach the distillation feature that renders the data stream incapable of being reconstructed by direct decipherment, the examiner never asserts at pages 5 and 6 of the answer that Tsuria teaches what is absent in Atkinson. Appellants' principal brief on appeal complains that the examiner has not accounted for these features which appellants again emphasize at the bottom of page 2 of the reply brief. It therefore appears to us that the examiner has not established pro forma a prima facie case of obviousness within 35 U.S.C. § 103 of the independent claims on appeal stated in the first stated rejection. It follows therefore that we cannot sustain the rejection of dependent claims 27 and 28 as well, even if we consider further the teachings of Ammar.

NEW REJECTIONS WITHIN 37 CFR § 1.196(b)

Our first new ground of rejection within 37 CFR § 1.196(b) applies to all claims on appeal, claims 1 through 12 and 18

through 28. After a detailed study of appellants' specification as filed, the drawings of record and the originally filed claims, we reject all these claims within the written description portion of 35 U.S.C. § 112, first paragraph.

Inasmuch as the distillation feature and its corresponding statement of each independent claim on appeal that the data stream is incapable of being reconstructed by direct decipherment was entered in an amendment, Paper No. 6, filed October 17, 2002, there is no originally filed basis for this feature and language. The use of the word "distillation" is nowhere to be found in the original filed specification and original claims and is not shown in the original drawings. The feature of the incapability of the data stream being reconstructed by direct decipherment is also not directly taught or indicated among these original portions of the specification as filed.

The specification as filed only operates on electronic signatures which are generated according to the showing in figure 5. The discussion of prior art figure 5 in the specification at page 11, lines 12 through 26, does not characterize any operations performed to yield a digital signature or electronic signature of any kind as being based upon any

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distillation or indicating the incapability of reconstructing the data stream by direct decipherment. The signature generator in 202 in figure 2 for original documents and the corresponding signature generator in figure 3B for potential infringing documents are not otherwise distinguished in setting forth and explaining these disputed features among all claims on appeal as well.

Therefore, it appears to us from our study of the totality of the specification as filed that there was no contemplation, no concept, no appreciation, and therefore no possession of the features recited in all claims on appeal of the electronic signature being a distillation of the data stream, where the distillation is incapable of being reconstructed by direct decipherment. We also wonder, by implication, if there appears to be an admitted capability of indirect decipherment.

We also reject independent claims 1, 7, 18 and 26 under 35 U.S.C. § 102 and, in the alternative, under 35 U.S.C. § 103 on the basis of Tsuria alone.

Although apparently not recognized by the examiner, the examiner's own assessment and brief explanation of Tsuria at the bottom of page 5 of the answer does correlate to the features

recited that are disputed in their entirety in each of the independent claims on appeal. The structure and signal environment of figure 1 and the functional operation thereof in figure 2 of Tsuria clearly meet the subject matter of all features recited in the independent claims on appeal. These include the generation of a first electronic signature and a second electronic signature corresponding to the showings of signatures 130 and 185 in figure 1, and the discussion in Tsuria that the signature computation devices 110 perform what amounts to a distillation of a data stream such that the data stream is incapable of being reconstructed by direct decipherment. Comparator 190 in figure 1 performs the claimed comparison operations between the two signatures that have been stored in respective devices in this figure. The functional comparison block 235 in flow chart figure 2 indicates that when a match is indicated between the two signatures, the likelihood of suspected copyright material is noted in such a manner as to yield a "yes" logical response to prevent playback of the recorded video representation in block 245. The illustrated video work may be a copyrighted video work as indicated at column 7, line 42.

The signature computations in Tsuria occur in accordance with the showings in figures 3, 4 and 6, as well as their corresponding discussions, which principally occur at columns 10 and 11. We recognize as well that Tsuria contains some teachings or suggestions of cryptographic approaches among the prior art known to him, but the principal thrust of Tsuria's teachings to yield an electronic signature clearly do not employ cryptographic approaches.

In this light, appellants' remarks at the bottom of page 5 of the principal brief on appeal relating to their characterization that Tsuria teaches digital signatures in one sense is agreed with but in others is not. Tsuria may teach to the artisan that digital signatures are performed by the nature of the operations and functions performed in this reference to generate digital signatures, but clearly the claimed electronic signature is generated in the reference. Appellants' remarks are not well received because they ask us to impute into Tsuria a definition of terms, in effect the words "digital signature," based upon a reference which has an effective date of April 2, 2003 where the filing date of the application is March 27, 2000. Since the digital signature guideline's tutorial in Appendix B

to the brief contains this later filing date, it is not available to the artisan to interpret correctly any meaningfulness of what an electronic signature in Tsuria may comprise. If we were to accept appellants' views as to this approach argued at the bottom of page 5 of the principal brief on appeal, that a digital signature or an electronic signature implicitly includes a cryptographic approach to arriving at the digital signature, thus ensuring the opposite of the claimed negative limitation of the incapability of reconstructing the data stream by direct decipherment, we would also have to impute the same to appellants' own disclosed approach.

To the extent appellants pursue either or both of these art rejections before the examiner, it is noted that the examiner is free from our perspective to extend those alternative rejections to respective dependent claims of each independent claim, and free to rely upon additional prior art that the examiner may become aware of.

In closing, we summarize our findings by first indicating that we have reversed the outstanding two rejections of all claims on appeal within 35 U.S.C. § 103. On the other hand, within the provisions of 37 CFR § 1.196(b), we have introduced

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new grounds of rejection for all claims on appeal, claims 1 through 12 and 18 through 28, as being based upon a failure to meet the written description portion of 35 U.S.C. § 112, first paragraph. We have also separately rejected independent claims 1, 7, 18 and 26 within 35 U.S.C. § 102 and, alternatively, within 35 U.S.C. § 103 based upon the teachings and showings in Tsuria alone.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b). 37 CFR § 1.196(b) provides that, "[a] new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

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(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

REVERSED 37 CFR § 1.196(b)

JAMES D. THOMAS
Administrative Patent Judge

KENNETH W. HAIRSTON
Administrative Patent Judge

HOWARD B. BLANKENSHIP
Administrative Patent Judge

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JDT:psb

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Bracewell & Patterson, LLP
Intellectual Property Law
P.O. Box 969
Austin, TX 78767-0969